

REMARKS

The Office Action mailed June 15, 2007, has been received and reviewed. Claims 2-11 are pending in the application. Claims 2, 5, 6, 9 and 10 were previously withdrawn from consideration. Claims 3, 4, 7, 8 and 11 stand rejected. Claim 3 is amended herein. Claims 4, 7, 8 and 11 are canceled. New claim 12 is added. No new matter is added. All amendments are made without prejudice or disclaimer. Reconsideration is requested.

35 U.S.C. §112

Claims 3, 4, 7-8 and 11 stand rejected under 35 U.S.C. §112, first paragraph, because the specification, while admittedly enabling for removing transposons flanked by FRT sequences, allegedly does not reasonably provide enablement for transposing a transposon that is not flanked by FRT sequences. Claims 4, 7, 8 and 11 are canceled. Thus, the rejection of these claims is moot. Applicants traverse the rejection of claim 3.

Specifically, it was thought that the specification lacked support for the claim element “using *Agrobacterium* to introduce an FLP-encoding DNA into a transformed plant that comprises the transposon.” It was alleged that it was not known in the art that the FLP site-specific recombinase is able to recognize any transposon without being flanked by FRT sequences. (Office Action, page 3). Applicants have amended claim 3 to remove reference to an “FLP-encoding DNA.” Reconsideration and withdrawal of the rejection is thus requested.

35 U.S.C. §102(b)

Claims 4 and 8 stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Weld et al. (2002, *Plant Cell, Tissue and Organ Culture* 69:45-54). Claims 4 and 8 have been canceled. Thus, the rejection of these claims is moot.

35 U.S.C. §103

Claims 7 and 11 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatenable over Weld et al. (2002, *Plant Cell, Tissue and Organ Culture* 69:45-54). Claims 7 and 11 have been canceled. Thus, the rejection of these claims is moot.

Claims 3, 4, 7, 8 and 11 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatenable over Gleave et al. (1999, *Plant Molecular Biology* 40:223-235). Claims 4, 7, 8

and 11 have been canceled. Thus, the rejection of these claims is moot. Applicants respectfully traverse the rejection of claim 3 as set forth herein.

Gleave discloses a leaf-disc method for generating marker free tobacco plants which involves excising discs from leaves and inducing regeneration of shoots from transformed discs. *See*, Horsch et al., "A Simple and General Method for Transferring Genes into Plants," Science, 8 Mar 1995 p. 1229-1231. A copy of this reference is provided in the Information Disclosure Statement Filed herewith.

By contrast, claim 3, as amended, recites "A method for transposing a transposon that does not have a transposase, wherein the method comprises the steps of: introducing a transposase-encoding DNA into a transformed plant that comprises the transposon lacking transposase by in planta transformation of *Agrobacterium*, and transiently expressing the transposase." Support for the amendment may be found throughout the as-filed specification including, for example, paragraph [0031].

In contrast with Gleave, claim 3 is directed to an in planta transformation method, which directly introduces the gene of interest into an intact plant and generates a transgenic plant without excision or regeneration. (Specification, paragraph [0031]). The method of amended claim 3 transforms a plant by, for example, immersing its floral tissue in an *Agrobacterium* solution, and is advantageous over conventional methods in that it does not require the step of tissue culturing and the possibility of somaclonal variation is low. (Specification, paragraph [0032]).

As Gleave fails to teach or suggest each and every element of amended claim 3, Gleave cannot render claim 3 obvious. Reconsideration and withdrawal of the rejection is requested.

New Claim

New claim 12 is added and finds support throughout the as-filed specification including, for example, paragraphs [0015], [0021], [0031]-[0033], and [0043]-[0045].

Conclusion

In view of the foregoing amendments and remarks, Applicants submit that the claims define patentable subject matter and a notice of allowance is requested. Should questions exist after consideration of the foregoing, the Office is kindly requested to contact the Applicants' attorney at the address or telephone number given herein.

Respectfully submitted,



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